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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,899	08/07/2000	David S. Gress	95-445	3635

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LEON R TURKEVICH  
2000 M STREET NW  
7TH FLOOR  
WASHINGTON, DC 200363307

EXAMINER

DINH, KHANH Q

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/633,899

Applicant(s)

GRESS ET AL.

Examiner

Khanh Dinh

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-34 are presented for examination.

***Information Disclosure Statement***

2. The information disclosure statement filed ON 12/1/2000 (paper # 4) fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the 1448 Form is not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international

application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 5, 9-13, 15, 18, 19, 22, 26, 26-29, 31 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Burg US pat. No.6,532,286.

As to claim 1, Burg discloses a method for playing a messaging prompt, the method comprising: receiving calling party number information specifying a calling party (15-10, 150-11 of fig.3) (see abstract, col.4 lines 5-67).

accessing stored calling party number information from an Internet Protocol (IP) based database server (using Internet Access Server IAS) configured for storing calling party number information (see col.5 line 37 to col.6 line 12).

comparing the received calling party number information to the stored calling party number to determine if there is a match between the received calling party information and the stored calling party information (checking the identity and password of the users, see col.6 line 13 to col.7 line 8) and based on a determined match, retrieving a personalized voice message corresponding to the matched, stored calling party number information, for playback as the messaging prompt (see fig.5, col.10 line 8 to col.12 line 53).

As to claim 2, Burg discloses the received and stored calling party number information each includes at least a portion of a telephone number of the calling party (see col.3 line 34 to col.4 line 44).

As to claim 5, Burg discloses retrieving the stored personalized voice message from the IP based database server (see col.7 line 36 to col.8 line 55).

As to claims 9 and 10, Burg discloses corresponding a flag to certain of the stored calling party number information, the flag indicating a calling feature defined by a called party for use by the calling party one of a paging operation and a single number reach operation (see col.3 line 34 to col.4 line 44 and col.7 line 36 to col.8 line 55).

As to claim 11, Burg discloses receiving a dialed number identification string (DNIS), and wherein the accessing step includes accessing a subscribers' profile based on the DNIS, the subscriber's profile including the stored calling party number information and the corresponding personalized voice message (see col.3 line 17 to col.4 line 67 and col.8 line 56 to col.10 line 41).

As to claim 12, Burg discloses a messaging system for playing a messaging prompt in response to a request for execution of a messaging operation, the request containing calling party number information, the messaging system including:

an application runtime environment configured for retrieving, for playback as the messaging prompt (see fig.3, abstract, col.5 line 37 to col.6 line 12), a personalized voice message based on a match of the received calling party number information with calling party number information stored in an Internet Protocol (IP) based database server, the personalized voice message corresponding to the matched (checking the identity and password of the users, see col.6 line 13 to col.7 line 8), stored calling number information of the calling party (see fig.5, col.10 line 8 to col.12 line 53).

Claims 13 and 15 are rejected for the same reasons set forth in claims 11 and 3 respectively.

Claims 18, 19, 22, 26-28 are rejected for the same reasons set forth in claims 1, 2, 5, 9-11 respectively.

Claims 29, 31 and 34 are rejected for the same reasons set forth in claims 12, 15 and 13 respectively.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3, 4, 6-8, 14, 16, 17, 20, 21, 23-25, 30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg US pat. No.6,532,286 in view of Wolfe et al US pat. No.6,507,817.

Claims 3, 4 and 6-8 are rejected for the same reasons set forth in item 4 above. Burg does not specifically disclose accessing the IP-based database server according to LDAP protocol, receiving an HTTP request from the calling party, generating an HTML page having XML tags and inserting a first media tag including a .wav file and a second media tag configured for controlling

playing of the .wav file. However, Wolfe discloses accessing the IP-based database server according to LDAP protocol, receiving an HTTP request from the calling party, generating an HTML page having XML tags and inserting a first media tag including a .wav file and a second media tag configured for controlling playing of the .wav file (see abstract, fig.1, col.2 lines 1-55, col.4 line 10 to col.5 line 56 and col.6 lines 7-67). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Wolfe's teachings into the computer system of Burg for generating and executing web applications because it would have users to deploy a scalable, open standards based form approval system on an open standards based Internet Protocol network using a telephone.

Claims 14, 16 and 17 are rejected for the same reasons set forth in claims 2, 7 and 8 respectively.

Claims 20, 21, 23-25 are rejected for the same reasons set forth in claims 3, 4, 6- 8 respectively.

Claims 30, 32 and 33 are rejected for the same reasons set forth in claims 14, 16 and 17 respectively.

***Other prior art cited***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. Dodrill et al., US pat. No.6,490,6544.
  - b. Doyle., US pat. No.6,073,007.
  - c. Rogers et al., US pat. No.,946,386.
  - d. DuVal, US pat. No.5,818,836.

***Conclusion***

9. Claims 1-34 are *rejected*.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam Hosain, can be reached on (703) 308-6662. The fax phone numbers for this group are:

After Final: (703) 746-7238


Official: (703) 746-7239

Non-Official/ Draft: (703) 746-7240

*A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U. S. C. Sect. 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

Khanh Dinh  
Patent Examiner  
Art Unit 2155  
7/24/2003

  
HOSAIN T. ALAM  
PRINCIPAL EXAMINER